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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/639,613	08/11/2003	Minyu Li	163.1321USC2	5398

23552 7590 12/06/2005

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EXAMINER	
COSTALES, SHRUTI S	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/639,613	LI ET AL.	
	Examiner	Art Unit	
	Shruti S. Costales	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/11/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement submitted on August 11, 2003 was filed in compliance with the provisions of 37 CFR § 1.97. Accordingly, the information disclosure statement filed by the applicant has been considered by the Examiner. It is to be noted however, with respect to the "Other Documents", the Examiner has not considered documents without dates and documents that are identified as U.S. patent applications cited by their respective serial numbers.

The documents cited on the information disclosure statement submitted on August 11, 2003 that do not provide a date have not been considered because in order to meet the requirement that each item of information in an information disclosure statement be identified properly as set forth by 37 CFR 1.98(b), each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and *date* and place of publication [*Emphasis Added*]. See 37 C.F.R. §§ 1.97 and 1.98 and M.P.E.P. § 609. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published. See MPEP § 609.

The documents that are identified as U.S. patent applications cited on the information disclosure statement submitted on August 11, 2003 by their respective serial numbers have not been considered by the Examiner because these documents are not printed publications that can be considered by the Examiner. See 37 C.F.R. §§ 1.97 and 1.98 and M.P.E.P. § 609. Instead, the Examiner has considered the corresponding patented documents for U.S. Serial Nos. 09/655,543 and 09/655,544. However, the Examiner cannot consider U.S. Serial No. 09/655,740 because this patent application was abandoned and never published.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

More particularly, the specification filed on August 11, 2003, identifies the title of the invention as "A CONTAINER, SUCH AS A FOOD OR BEVERAGE CONTAINER, LUBRICATION METHOD" as opposed to the declaration which identifies the title of the invention as being "A CONTAINER, SUCH AS A BEVERAGE CONTAINER, LUBRICATION METHOD". Therefore, the specification to which the oath or declaration is directed has not been adequately identified.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, 10, 11, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) More particularly, claim 2 recites the limitation "the liquid lubricant" at line 1 of claim 2, wherein there is insufficient antecedent basis for this limitation in the claim. Claims 3, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(ii) Further, claim 18 recites the limitation "an unlubricated margin", wherein it is not clear to one of ordinary skill in the art what is meant said limitation. Claim 18 also recites the limitation "on the conveyor edge", wherein there is insufficient antecedent basis for "the conveyor edge". Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

(iii) Claim 19 recites the limitation "the unlubricated margins", wherein there is insufficient antecedent basis for more than one margin. Further, it is not clear to one of ordinary skill in the art what is meant by the limitation "unlubricated margins". Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 9, 12-14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 93/18120 to Henkel.

Henkel discloses chain conveyor lubricants forming clear solutions in water, wherein these lubricants have a good coefficient of friction and generate little foam (Col. 3, lines 2-36). The lubricants of Henkel also exhibit high capillary activity and film formation on surfaces (Col. 3, line 62), therein inherently forming a continuous film. These lubricants are used as chain conveyor lubricants in the food industry for lubricating, cleaning, and disinfecting automatic chain conveyors of the type used in the packaging of foods, preferably beverages, in glass and plastic bottles, cans, glasses, kegs, papers, and cardboard containers (Col. 1, lines 11-18). The plastic bottles may be made of polyethylene terephthalate or polycarbonate (Col. 6, lines 14-32). Henkel discloses speed of the bottle conveyor as being approximately 1 m/s (Col. 6, lines 45-62), therein inherently implying that during lubrication the bottles move from a first position to a second position. Further, Henkel discloses that spraying nozzles are used (Col. 6, lines 57-62). The coefficient of friction is less than 0.15 (Col. 7, lines 9-12). No stress cracking occurs (Col. 6, lines 27-28), therein inherently preserving the shape of the containers. It is to be noted that a preamble is generally not accorded any

patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is noted that when utilizing WO 93/18120 in the above paragraph, the disclosures of the reference are based on U.S. Patent Number 6,372,698 which is an English language equivalent of the reference. Therefore, the column and line numbers cited with respect to WO 93/18120 are found in U.S. Patent Number 6,372,698.

In light of the above discussion, it is clear that the presently cited claims are anticipated.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/18120 to Henkel in view of Gutzmann (U.S. Patent Number 5,352,376).

Henkel discloses chain conveyor lubricants forming clear solutions in water, wherein these lubricants have a good coefficient of friction and generate little foam (Col. 3, lines 2-36). The lubricants of Henkel also exhibit high capillary activity and film formation on surfaces (Col. 3, line 62), therein intrinsically forming a continuous film. These lubricants are used as chain conveyor lubricants in the food industry for lubricating, cleaning, and disinfecting automatic chain conveyors of the type used in the packaging of foods, preferably beverages, in glass and plastic bottles, cans, glasses, kegs, papers, and cardboard containers (Col. 1, lines 11-18). The plastic bottles may be made of polyethylene terephthalate or polycarbonate (Col. 6, lines 14-32). Henkel discloses speed of the bottle conveyor as being approximately 1 m/s (Col. 6, lines 45-

62), therein intrinsically implying that during lubrication the bottles move from a first position to a second position. Further, Henkel discloses that spraying nozzles are used (Col. 6, lines 57-62). The coefficient of friction is less than 0.15 (Col. 7, lines 9-12). No stress cracking occurs (Col. 6, lines 27-28), therein intrinsically preserving the shape of the containers. It is to be noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The difference between Henkel and the presently claimed invention is the requirement that 5 to 50 wt% of an emulsion includes the aqueous phase.

Gutzmann, which is drawn to a conveyor lubricant that reduces stress cracking in thermoplastic containers being transported in food processing plants (Col. 1, lines 6-10), wherein the conveyor moves continuously and transports a container (Col. 4, lines 46-64), discloses that water is present in the lubricant in an amount of 2% to about 96% by weight (Col. 4, lines 57-64). It is further disclosed that the addition of stabilizing agents to maintain homogeneity and reduce phase separation (Col. 9, lines 22-32). Gutzmann further discloses that the application of the lubricant may be by means of spraying, immersing, brushing (Col. 4, lines 53-54). It would have been obvious to one of ordinary skill in the art to add the specified amount of water as disclosed by Gutzmann into Henkel's lubricant to intrinsically obtain an emulsion having an aqueous phase and

an organic phase due to the presence of water and the lubricant because while transporting thermoplastic containers in food processing plants stress cracking would be reduced (Col. 5, lines 18-64), thereby obtaining the invention as set forth in the presently cited claims.

It is noted that when utilizing WO 93/18120 in the above paragraph, the disclosures of the reference are based on U.S. Patent Number 6,372,698 which is an English language equivalent of the reference. Therefore, the column and line numbers cited with respect to WO 93/18120 are found in U.S. Patent Number 6,372,698.

9. Claims 6-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel in view of Gutzmann as applied to claims 1-5 and 9-16 above, and further in view of Person Hei et al. (U.S. Pre-Grant Publication Number 2002/0025912), which was cited by the applicant on the PTO-1449 submitted on August 11, 2003.

The difference between Henkel in view of Gutzmann and the presently claimed invention is the requirement that the lubricant is applied onto the conveyor in a specified manner.

Person Hei, which is drawn to conveyor lubricants and lubricant compositions and methods of use (Page 1, paragraph [0001]), discloses the lubricant layer on the conveyor surface has a thickness of less than about 3 millimeters with an add on of lubricant on the surface of less than about 0.05 grams per inch square (Page 4, paragraph [0026]). It is further disclosed that PET beverage containers commonly have pentaloid bases (Page 4, paragraph [0026]). Person Hei further discloses that the

container is filled with carbonated beverage and the interior of the container is maintained under substantial pressure (claim 49). It is also disclosed that the width of the lubricated area on the conveyor is about 3 to 150 inches and the unlubricated margins are greater than about 0.5 inches (claims 51 and 52). It would have been obvious to one of ordinary skill in the art to incorporate Person Hei's specific application of the lubricant on the conveyor because such a lubrication method prevents the undesirable interaction between the stressed thermoplastic and stress cracking promoters resulting in the inhibition of stress cracking of containers (Page 1, paragraph [0002]), thereby obtaining the invention as set forth in the presently cited claims.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

It is to be noted that four obviousness-type double patenting rejections are set forth below, wherein each rejection is designated sequentially by the letters A-D.

Double Patenting Rejection - A

11. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 8-24 of U.S. Patent No. 6,806,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim 8 of the '240 patent recites a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, the method comprising (a) forming a continuous thin film of a liquid lubricant composition on a container contact surface of a conveyor, and (b) moving a container on the conveyor surface in order to transport the container from a first location to a second location. Although claim 8 of the '240 recites a "liquid lubricant composition" compared to a "liquid composition" of presently claimed claim 1, the applicant recites "the liquid lubricant composition" in presently claimed claim 2. Claims 9-24 recite the features presently claimed in claims 2-20.

12. Claims 1-20 are directed to an invention not patentably distinct from 8-24 of the commonly assigned patent, namely U.S. Patent No. 6,806,240. Specifically, refer to the discussion above in paragraph 11.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 6,806,240, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting

inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Double Patenting Rejection – B

13. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 36-52 of U.S. Patent No. 6,673,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim 36 of the '753 patent recites a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, the method comprising (a) forming a continuous thin film of a liquid lubricant composition on a container contact surface of a conveyor, and (b) moving a container on the conveyor surface in order to transport the container from a first location to a second location. Although claim 36 recites a "liquid lubricant composition" compared to a "liquid composition" of presently claimed claim 1, the

applicant recites "the liquid lubricant composition" in presently claimed claim 2. Claims 37-52 recite the features presently claimed in claims 2-20.

14. Claims 1-20 are directed to an invention not patentably distinct from claims 36-52 of the commonly assigned patent, namely U.S. Patent No. 6,673,753. Specifically, refer to the discussion above in paragraph 13.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 6,673,753, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

15. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over claims 36-52 of the commonly assigned patent, namely U.S. Patent No. 6,673,753. Please refer to the discussion above in paragraph 13.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Double Patenting Rejection – C

16. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 1, 2, 4, 5, and 8-20 of U.S. Patent No. 6,427,826, which was cited by the applicant on the PTO-1449 submitted on August 11, 2003. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim 1 of the '826 patent recites a method of lubricating the interface between a container and a moving conveyor surface, the method comprising (a) forming a continuous thin film of an aqueous liquid lubricant composition, the lubricant comprising about 5 to 50 wt % of an aqueous phase, on a container contact surface of a conveyor in an amount of about $2X10^{-4}$ to 0.05 grams of liquid lubricant per each square inch of surface, the thickness of the continuous thin film of lubricant comprising a minimum thickness of an amount sufficient to provide minimum lubricating properties up to about 5 millimeters, and (b) moving a container on the conveyor surface in order to transport the container from a first location to a second location in the substantial absence of foamed lubricant and lubricant runoff. Claim 1 of the present invention is a narrower embodiment of '826's claim 1. However, when claim 1 of the present application is combined with claims 3, 6, and 7 of the present application, the resulting claim is the same as claim 1 of '826. Therefore, it would have been obvious to one of ordinary skill in the art to obtain claims 1-20 of the present application by forming various combinations of claims 1, 2, 4, 5, and 8-20 of the '826 patent.

17. Claims 1-20 are directed to an invention not patentably distinct from claims 1, 2, 4, 5, and 8-20 of the commonly assigned patent, namely U.S. Patent No. 6,427,826. Specifically, refer to the discussion above in paragraph 16.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 6,427,826, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly

assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Double Patenting Rejection – D

18. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-52 of copending Application No. 10/614,474, published as U.S. Pre-Grant Publication Number 2004/0058829. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim 36 of the '474 copending application recites a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, the method comprising (a) forming a continuous thin film of a liquid lubricant composition on a container contact surface of a conveyor, and (b) moving a container on the conveyor surface in order to transport the

container from a first location to a second location. Although claim 36 recites a "liquid lubricant composition" compared to a "liquid composition" of presently claimed claim 1, the applicant recites "the liquid lubricant composition" in presently claimed claim 2. Claims 37-52 recite the features presently claimed in claims 2-20.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1-20 are directed to an invention not patentably distinct from claims 36-52 of the commonly assigned copending application, namely 10/614,474. Specifically, refer to the discussion above in paragraph 18.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned copending Application No. 10/614,474, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

20. Claims 1-20 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/614,474 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application. Please refer to the discussion above in paragraph 18.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shruti S. Costales whose telephone number is (571) 272-8389. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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December 1, 2005

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